

REMARKS

Applicants respectfully request reconsideration of the present Application. Claims 1-11, 13-19, 21-29, 31, and 32 have been amended and claims 12 and 30 have been cancelled. Care has been exercised to introduce no new matter. Claims 1-11, 13-19, 21-29, 31, and 32 are pending and are in condition for allowance.

Rejections based on 35 U.S.C. § 101

Claims 1-19 and 21-32 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-11, 13-19, 21-29, 31, and 32 have been amended to recite “computer storage media” as the Office has indicated that “computer storage media is statutory”. ¶5 of the 3/31/2010 Office Action. This distinction between computer storage media and communication media is supported in paragraph 25 of the present application. Further, Applicants respectfully disagree that claim 1 is drawn to nonfunctional descriptive material. The container of claim 1 is configured to perform and allow a variety of functions, which are clearly articulated by the claims. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejections based on 35 U.S.C. § 103

Claims 1-19 and 21-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nusser, et al. U.S. Patent No. 7,093,296 and Newman, et al. U.S. Publication No. 2005/0280853 and Wilkins, et al. U.S. Patent No. 7,042,583 and Haikin, et al. U.S. Patent No. 6,603,879 and further in view of Ta, et al. U.S. Patent No. 7,359,884.

Claims 23-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Newman, et al. U.S. Publication No. 2005/0280853, Nusser, et al. U.S. Patent No. 7,093,296,

Haikin, et al. U.S. Patent No. 6,603,879 and Wilkins, et al. U.S. Patent No. 7,042,583 further in view of Ta, et al. U.S. Patent No. 7,359,884.

A. Applicable Authority

To sustain a rejection of a claim under 35 U.S.C. § 103(a), the Examiner must find that a preponderance of the evidence supports a finding of obviousness. The Examiner bears the initial burden of showing that the reference teachings establish a *prima facie* case of obviousness. “In view of all factual information, the examiner must . . . make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” MPEP § 2142 (explaining that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious”). In making that determination, the Examiner must consider every word in each claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, “[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Supreme Court indicated that “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art . . . to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007). However, if the references do not “expressly or impliedly suggest the claimed invention,” the examiner must present “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the

teachings of the references.” MPEP § 706.02(j) and § 2142, quoting *Ex parte Clapp*, 227 USPQ 972, 972 (Bd. Pat. App. & Inter. 1985).

Further, “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.” MPEP § 2145, quoting, *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

B. Rejections under §103

Applicants have amended the independent claims to include the limitation of claims 12 and 30, that the container is configured to “permit incorporation of executable code”, to further distinguish the claims from the cited art. For example, Applicants’ invention can accommodate a gamut mapping algorithm for color management processing. *See* ¶46 of the present invention.

The Office cites language from both Newman and Nusser in an obvious rejection of claims 12 and 30. However, that language from the references is merely boilerplate language specifying that the methods therein disclosed may be carried out by any computing device. Specifically, in rejecting claim 12, the Office cites column 11, lines 2-6 in Nusser, which reads, “[a] typical combination of hardware and software could be a general purpose computer system with a computer program that, when being loaded and executed, controls the computer system such that it carries out the methods described herein.” Further, in rejecting claim 30, the Office cites paragraph 60, lines 6-9 of Newman, which reads, “[i]n addition, the invention can be

implemented in a computing device, and can be implemented in computer-executable process steps stored in a computing device or on a computer-readable medium.”

Although Nusser and Newman use the terms “executed” and “computer-executable” respectively in these passages, their use has an entirely different meaning than Applicants’ use of “executable code”. In no way does either reference teach a container “configured to permit incorporation of executable code”. Rather, Nusser and Newman are referring to their inventions generally, that the methods they teach may be implemented by a computer. Nowhere does Newman or Nusser teach that the color characterization profile itself may allow the incorporation of executable code.

Moreover, Newman utilizes hash codes corresponding to a device transform to look for the transform in a transform cache, and if one is not available, generates a transform based on measurement data in the profile. Thus, the entire purpose of the Newman invention is to correlate a hash code with a transform stored in persistent memory, thereby **teaching away** from storing an executable code in the profile. As each of the independent claims recite this limitation, Applicants respectfully assert that all claims are now in condition for allowance.

CONCLUSION

For at least the reasons stated above, claims 1-11, 13-19, 21-29, 31, and 32 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or awingrove@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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